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MCCARTER & ENGLISH, LLP BOSTON
265 Franklin Street
Boston MA 02110

In re Patent No. 7,553,828 :
Nelson et al. :
Issue Date: June 30, 2009 :
Application No. 10/786,881 : DECISION ON REQUEST FOR
Filed: February 24, 2004 : RECONSIDERATION OF
Attorney Dkt. No. 117728-22201 : PATENT TERM ADJUSTMENT
Title: 9-AMINOMETHYL :
SUBSTITUTED MINOCYCLINE :
COMPOUNDS :

This is a decision on the "APPLICATION FOR PATENT TERM ADJUSTMENT INCLUDING REQUEST FOR RECONSIDERATION UNDER 37 C.F.R. § 1.705(d)," filed August 27, 2009, requesting that the patent term adjustment determination for the above-identified patent be changed from three hundred fifty-eight (358) days to seven hundred three (703) days.

The request for reconsideration of patent term adjustment is **DISMISSED**.

On June 30, 2009, the above-identified application matured into US Patent No. 7,553,828 with a patent term adjustment of 358 days. This request for reconsideration of patent term adjustment was timely filed within two months of the issue date of the patent. See 37 C.F.R. § 1.705(d).

The Office acknowledges submission of the \$200.00 fee set forth in 37 C.F.R. § 1.18(e). No additional fees are required.

Patentees assert entitlement to a patent term adjustment of 703 days. Patentees maintain the 345 of 856 days delay under § 154(b)(1)(B) do not overlap with the delay under § 154(b)(1)(A). Thus, patentees request that the determination of patent term adjustment be increased to a total of seven hundred three (703) days (the sum of the period of three-year delay (856 days) and

the period of examination delay (570 days) minus applicants' delay (212 days) minus time consumed by the request for continued examination (RCE) pursuant to 37 CFR 1.703(b)(1) (491 days) minus time consumed by filing of the Notice of Appeal pursuant to 37 CFR 1.703(b)(4) (20 days))¹. Patentees do not dispute the 212-day reduction for applicants' delay.

The Office finds that as of the day before the filing of the request for continued examination (RCE) on February 25, 2008, the application was pending three years and 366 days after its filing date (February 25, 2007 to February 25, 2008). At the time of filing of the RCE on February 26, 2008, a period of adjustment of 535 days was entered for Office delay pursuant to 37 CFR 1.702(a)(1). At issue is whether patentee should accrue an additional 366 days of patent term adjustment for the Office taking in excess of three years to issue the patent as well as 535 days for Office failure to take a certain action within a specified time frame (or examination delay).

The Office contends that the entire 366-day period of delay in issuance of the patent overlaps with the period of 535 days of examination delay. Patentees' calculation of the period of overlap is inconsistent with the Office's interpretation of this provision. 35 U.S.C. 154(b)(2)(A) limits the adjustment of patent term, as follows:

To the extent that the periods of delay attributable to grounds specified in paragraph (1) overlap, the period of any adjustment granted under this subsection shall not exceed the actual number of days the issuance of the patent was delayed.

Likewise, 37 CFR 1.703(f) provides that:

To the extent that periods of delay attributable to the grounds specified in §1.702 overlap, the period of adjustment granted under this section shall not exceed the actual number of days the issuance of the patent was delayed.

As explained in *Explanation of 37 CFR 1.703(f) and of the United States Patent and Trademark Office Interpretation of 35 U.S.C.*

¹As 37 CFR 1.702(b)(4) is not applicable to the instant prosecution history, consideration of a 20 day overlap under 37 CFR 1.703(b)(4) as discussed by patentees is not warranted.

154(b)(2)(A), 69 Fed. Reg. 34283 (June 21, 2004), the Office interprets 35 U.S.C. 154(b)(2)(A) as permitting either patent term adjustment under 35 U.S.C. 154(b)(1)(A)(i)-(iv), or patent term adjustment under 35 U.S.C. 154(b)(1)(B), but not as permitting patent term adjustment under both 35 U.S.C. 154(b)(1)(A)(i)-(iv) and 154(b)(1)(B). Accordingly, the Office implements the overlap provision as follows:

If an application is entitled to an adjustment under 35 U.S.C. 154(b)(1)(B), the entire period during which the application was pending (except for periods excluded under 35 U.S.C. 154(b)(1)(B)(i)-(iii)), and not just the period beginning three years after the actual filing date of the application, is the period of delay under 35 U.S.C. 154(b)(1)(B) in determining whether periods of delay overlap under 35 U.S.C. 154(b)(2)(A). Thus, any days of delay for Office issuance of the patent more than 3 years after the filing date of the application, which overlap with the days of patent term adjustment accorded prior to the issuance of the patent will not result in any additional patent term adjustment. See 35 U.S.C. 154(b)(1)(B), 35 U.S.C. 154(b)(2)(A), and 37 CFR § 1.703(f). See *Changes to Implement Patent Term Adjustment Under Twenty Year Term; Final Rule*, 65 Fed. Reg. 56366 (Sept. 18, 2000). See also *Revision of Patent Term Extension and Patent Term Adjustment Provisions; Final Rule*, 69 Fed. Reg. 21704 (April 22, 2004), 1282 Off. Gaz. Pat. Office 100 (May 18, 2004). See also *Explanation of 37 CFR 1.703(f) and of the United States Patent and Trademark Office Interpretation of 35 U.S.C. 154(b)(2)(A)*, 69 Fed. Reg. 34283 (June 21, 2004).

As such, the period for over 3 year pendency does not overlap only to the extent that the actual dates in the period beginning three years after the date on which the application was filed overlap with the actual dates in the periods for failure of the Office to take action within specified time frames.

In this instance, the relevant period under 35 U.S.C. 154(b)(1)(B) in determining whether periods of delay "overlap" under 35 U.S.C. 154(b)(2)(A) is the entire period during which the application was pending before the Office, February 24, 2004 until the day before the filing of the RCE on February 25, 2008. 535 days of patent term adjustment were accorded prior to the filing of the RCE for the Office failing to respond within

specified time frames during the pendency of the application. All of the 366 days for Office delay in issuing the patent overlap with the 535 days of Office delay accrued prior to submission of the RCE. Entry of both 366 days pursuant to 37 CFR §1.702(b) for the Office taking in excess of three years to issue the patent and 535 days pursuant to 37 CFR §1.702(a)(1) for Office examination delay is neither permitted nor warranted. The Office did not delay 535 days and then another 366 days. As of the filing of the RCE on February 26, 2008, the greater period, 535 days, is the actual number of days issuance of the patent was delayed by the Office. An additional 35-day patent term adjustment was accorded subsequent to the filing of the RCE.

Accordingly, at issuance, the Office properly entered no additional days of patent term adjustment for the Office taking in excess of 3 years to issue the patent, having considered the 535 days of examination delay under 37 CFR 1.702(a)(1) that occurred prior to the filing of the RCE as well as the 35 days of examination delay under 37 CFR 1.702(a)(2) that occurred subsequent to the filing of the RCE, as well as the applicant delays of 212 days under 37 CFR 1.704.

In view thereof, no adjustment to the patent term will be made.

Telephone inquiries specific to this matter should be directed to Charlema Grant, Petitions Attorney, at (571) 272-3215.

/ALESIA M. BROWN/

Alesia M. Brown
Petition Attorney
Office of Petitions